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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/697,237

10/31/2003

Nobuyuki Nonaka

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

03/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/697,237	Applicant(s) NONAKA, NOBUYUKI	
	Examiner ROBERT MOSSER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on the 14th January 2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *display shielding and a display device with an inherent thickness*, does not reasonably provide enablement for *characterizing the thickness of the display shielding unit as less than the thickness of the third display device*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The newly presented features are not described within the specification of the present application. The features and aspect related to scale, thickness or measurement are not described within the specification. On page 15 of the applicant

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remarks dated the applicant remarks dated December 12th, 2008 the applicant points to the figures of the instant application as providing support for the newly claimed features.

With respect to reliance on drawings for providing enabling disclosure the MPEP presents the following.

PICTURES MAY CONSTITUTE AN "ENABLING DISCLOSURE"

Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured. Therefore, such an enabling picture may be used to reject claims to the article. However, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). (MPEP 2121.04)

Reviewing the applicant cited figures (Figures 5, 8(b), 9) and the applicant's specification there is no language to suggest that the drawings are drawn to scale. With relation to the consideration of scale and proportion the MPEP presents the following.

PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int 'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."). (MPEP 2125)

Accordingly the applicant reliance on the figures of the present application to provide a basis for demonstrating ratios of relative thickness of elements contained therein is improper because these ratios are not fairly reflected within the presented drawings and

the drawings themselves are not indicated as being reflective of scale as would be required for such an enabling basis to be present.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1, 3, and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al (US 2005/0192090).

[The section presented below entitled Response to Arguments is incorporated herein.]

Muir teaches a gaming machine including:

a game result display means comprising a first display component of a reel type display (*Muir* Figure 8, Paragraph 41) , a second display component of a LCD type display (*Muir* Figure 8, Paragraph 48), and a third display component of a liquid crystal shutter wherein the third display element selectively blocks the transmission of the reel image display component and selective enables the transmission of the LCD image component (*Muir* Figure 8, Paragraph 61-65) wherein the second and third display elements are shown in a “one piece construct” (*Muir* Figure 8);

a value providing device to provide game payouts to the player based on game outcomes (*Muir* Paragraph 47); and

a controller for controlling the operation (*Muir* Paragraph 45).

Muir is silent regarding describing the inclusion of the claimed second and third display elements as a “unitary” construction however the applicant’s specification (paragraphs 16–17, and 21) teaches that the particular arrangement of these components is immaterial to the invention. As disclosed this arrangement is not material to the invention as presented and further represents a mere rearrangement of parts and/or the making integral of separately presented parts as defined in MPEP sections 2144.04(V)(B) and 2144.04(VI)(C).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the second and third display into a one-piece “unitary” construction because such modification presents mere rearrangement of parts and/or the making integral of separately presented parts that fails to distinguish over the prior art and further because such a modification would represent the combination of known elements through established means with predictable and expected results of reducing the number of parts required for unit assembly well within the skill of an ordinary worker in the art and disclosed as being immaterial to the invention.

In the amendment entered on the 14th, January 2009 the applicant amends the claims to include a display shield and third display thickness. As the third display and display shielding are physical components (and by extension inherently containing a mass and volume) of the combination as presented above they are understood to inherently have a thickness extending in every direction including the light emitting direction by nature of the physical properties of the mass composing these elements.

Additionally presented in the amendment entered on the 14th, January 2009 the applicant amendment reflects that the thickness of the display shielding component is less than the thickness of the third display component in a light emitting direction. The relative sizing of the third display and display shielding components would have been obvious to one of ordinary skill in the art at the time of invention because such a conventional modification of component thickness would yield an expected and predictable result as defined by MPEP 2144.04(IV) and would have enabled the construction of a display element containing the display shielding and third display requiring less physical space than the same element composed of two components of equivalent thickness to the third display component.

Claims **6-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al (US 2005/0192090) in view of Lee et al (US 6,847,416)

Muir teaches a gaming machine as presented above in the rejection of at least claims **1**, **3**, and **5** however, Muir does not specifically teach the use of reflection plates and diffusion sheets in the construction of display devices. In a related teaching however Lee teaches the utilization of diffusion sheets and reflection plates are known elements in the construction of display devices (Lee Abstract Col 2:60-65). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the known elements of reflection plates and diffusion sheets into the display arrangement of Muir to allow the equalize lighting of display surfaces and further because such an arrangement would have represented a combination of known

components according to known function through conventional means to obtain predictable and expected results of emitting light in a desired direction with a desired amount of diffusion.

Response to Arguments

Applicant's arguments entered January 14th, 2008 (originally submitted December 12th, 2008) have been fully considered but they are not persuasive.

Issues of scope of enable have been addressed in the rejections as presented above while the newly claimed features have been addressed in the rejection as presented above.

As the applicant's arguments are directed to the absence of these newly presented features they have been accordingly addressed in the above presented rejections and are considered redressed therewith.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

/R. M./
Examiner, Art Unit 3714